

REMARKS

By the present amendment, Applicants have amended Claims 1, 10, 11, 14 and 15, and cancelled Claims 6, 13 and 20. Claims 1-5, 7-12, and 14-19 remain pending in the present application. Claims 1, 11 and 15 are independent claims.

The Examiner objected to Claim 10 for informalities, particularly for the lack of antecedent basis for "said clamping device" and for using "a fixed jaw" and "a stationary jaw" to refer to the same element. Accordingly, Applicants have amended Claim 10 to refer to "said" clamp", and to substitute "the fixed jaw" for "a stationary jaw." Applicants submit that these amendments correct the informalities noted by the Examiner.

In the recent Office Action the Examiner rejected Claims 13-14 under 35 U.S.C. § 101 as being directed towards non-statutory subject matter. Claim 15 was rejected under 35 U.S.C. § 102(b) as being anticipated by Glick (U.S. Patent No. 5,693,073). Claims 1-3, 5 and 7-12 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Kolbel (U.S. Patent No. 3,750,655) in view of Moriarty (U.S. Patent No. 6,193,742). Claim 4 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Kolbel in view of Moriarty, and further in view of Glick. The cancellation of Claim 13 by the present amendment serves to render these particular grounds of rejection moot as to that claim. The indication by the Examiner that Claims 6 and 16-20 would be allowable if rewritten in independent form, and that claims 13-14 would be allowable if amended to overcome the rejection under § 101 and further rewritten in independent form, including all of the limitations of the base claim and of any intervening claims, is noted with appreciation.

Applicants have amended independent Claim 1 to incorporate the allowable subject matter of Claim 6. For this reason, Applicants submit that independent claim 1 and dependent claims 2-5 and 7-10 are allowable over the prior art of record.

Applicants have amended independent Claim 11 to incorporate the allowable subject matter of Claim 13. Claim 14 has been amended to change the dependency from Claim 13 to Claim 11.

With respect to the rejection of dependent Claim 13, now incorporated into Claim 11, Applicants respectfully traverse the rejection. It is a fundamental technical rule of claims drafting that an element of a claim can only be introduced as a subject of the clause introducing the element (or more properly, as one of the conjunctive direct objects of the transitional phrase “comprising”), or as related to a previously introduced element by a verb describing a state of being, such as having, comprising, including, being, etc., e.g., “an A having a B and a C” positively claims B and C. An element cannot be introduced in the middle of a clause as acting upon, or being acted upon by, a previously introduced element. On the other hand, a workpiece or unclaimed environmental elements can be, and often is, introduced in the middle of a clause as being acted upon or acting upon elements of the claim. See Landis, *Mechanics of Claims Drafting*, Robert C. Faber, ed., 4th edition, December 1999, Sections 16 and 16A. In original dependent Claim 13, the “attachment means” is further limited to attachment means which include “a post” and “a keeper.” The “wearer’s pierced body part” recited in original Claim 13 is a workpiece or environmental element not being claimed as part of the invention, but describing the environment upon which the post and keeper operate. In amending independent Claim 11 to incorporate the allowable subject matter of Claim 13, Applicants have added the additional functional language “said post being adapted for insertion through the body part of the user” to lines 9 and 10 to clarify that the body part is not being claimed as an element of the invention. For these reasons, Applicants respectfully submit that independent Claim 11 and corresponding dependent Claims 12 and 14 are allowable over the prior art applied of record.

Applicant has amended independent Claim 15 to incorporate the allowable subject matter of dependent Claim 20. For this reason, Applicants submit that independent claim 15 and dependent claims 16-19 are allowable over the prior art of record.


For these reasons, Applicants submit that the present application is now in condition for allowance, and reconsideration is respectfully requested. Applicant points out that the present Office Action (Paper No. 18) is the fourth Office Action affecting the present application. Further, the art applied in the present Office Action was initially cited as pertinent in the second Office Action (Paper No. 10), but not applied in either the second or third Office Actions as either a primary or secondary reference. Still further, although the present Office Action includes a 35 U.S.C. § 102(b) and several 35 U.S.C. § 103(a) rejections, none of the references applied in the present Office Action show or suggest a "jewelry item" or "jewelry device" worn on the body (Kolbel shows a handheld massager for massaging the face; Moriarty and Glick show pacifiers), so that it is extremely unlikely that such rejections would be upheld on appeal, particularly in light of *Corning Glass Works v. Sumitomo Electric U.S.A., Inc.*, 868 F.2d 1251, 9 USPQ2d 1962 (Fed. Cir. 1989) (preamble claiming "an optical wave guide" is a positive limitation distinguishing references structurally similar but not used as optical wave guides), even assuming that the references show every element and every limitation on the elements in the present claims, as currently amended. Moreover, the present fourth Office Action includes a first-time rejection of original Claim 13, under § 101.

Applicants respectfully remind the Examiner that MPEP 707(g) provides that piecemeal examination should be avoided as much as possible and that each claim should be rejected on "all valid grounds available." There is no apparent reason why the § 101 rejection to Claim 13 could not have been made in the first Office Action and resolved long ago. Claim 15 was first introduced in the response to the first Office Action and has not been amended until the present Office Action, so that there is no apparent reason that the rejection of Claim 15 under 35 U.S.C. § 102(b) over the Glick pacifier could not have been made in either the second or third Office Actions. Similarly, Claims 1 and 11 were not amended in response to the third Office Action, so that there is no apparent reason that the 35 U.S.C. § rejection of those Claims could not have been made at least in the third Office Action.

Applicants believe that the Examiner's application of the Kolbel, Moriarty and Glick references to reject the Claims of the present application is defective and inappropriate on its merits. Nevertheless, the present application has been pending for over three years, and Applicants have already had two personal interviews with the Examiner in an attempt to resolve all outstanding objections and rejections. By the present amendment, Applicants have amended the claims in the present application in a good faith effort to incorporate the allowable subject matter indicated by the Examiner in the present Office Action in order to terminate prosecution. Reconsideration is respectfully requested.

For the foregoing reasons, Applicants respectfully submit that the present application is in condition for allowance. If such is not the case, the Examiner is requested to kindly contact the undersigned in an effort to satisfactorily conclude the prosecution of this application.

Respectfully submitted,



Robert B. Lyons
Registration No. 40,708
(703) 486-1000

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